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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/328,356    10/24/94    CONNOLLY    D    1124.025

26M2/0724

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TROST EXAMINER

ART UNIT

PAPER NUMBER

2608

10

DATE MAILED:

07/24/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/328,356

Applicant(s)

Connolly et al

Examiner

William Trost

Group Art Unit

2608



☒ Responsive to communication(s) filed on May 29, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-102 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-102 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. § 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose material information as defined in 37 C.F.R. § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

2. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-102 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-65 of U.S. Patent No. 5,325,418 in

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view of Schellinger et al (hereinafter Schellinger) or Dent et al (hereinafter Dent).

Regarding claims 1-102, U.S. Patent No. 5,325,418 (hereinafter Connolly) discloses a wireless personal communications system (PCS) which comprises intelligent handsets, intelligent base stations, and allows for two-way voice/data/image calls and intercell hand-off, where the PCS network uses ISDN and AIN technologies, and the network contains the intelligent handset features and profiles (See claims 1-65). Connolly fails to disclose the use of fixed terminals which communicate with the wireless network.

On the other hand, Schellinger or Dent teach the use of fixed terminals (cordless base station 115 - Schellinger, base station 110 - Dent) which interface with the cellular system. Schellinger or Dent further disclose such features as registration, inter-cell handoff, and channel allocation (Schellinger - Col. 5;52-Col. 6;10, Col. 8;25-35, 54-61, Col. 12;58-Col. 13;41, claims 1-2; Dent - Col. 5;8-60, Fig. 6, claims 11-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to add fixed terminals to a wireless network, as taught by Schellinger or Dent, to Connolly, in order to allow obviate the need for costly telephone line installation.

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4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bendixen et al disclose the use of fixed terminals which can access the cellular network.

Harris discloses a cellular pay station.

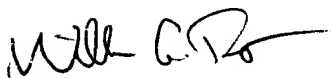
Brennan et al disclose the storing of profile information in a PCS system for wired and wireless subscribers.

5. Applicant's arguments with respect to claims 1-102 have been considered but are deemed to be moot in view of the new grounds of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Trost whose telephone number is (703) 308-5318. The examiner can normally be reached on Monday-Friday from 7 a.m to 3:30 p.m. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

  
CURTIS KUNTZ  
SUPERVISORY PATENT EXAMINER  
GROUP 2600

  
William Trost  
July 15, 1996